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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,838	03/22/2001	Robert Ichio	4168	6410
7590	11/01/2007		EXAMINER	
Harris Zimmerman Law Offices of Harris Zimmerman 1330 Broadway, Suite 710 Oakland, CA 94612-2506			JANVIER, JEAN D	
		ART UNIT	PAPER NUMBER	
		3622		
			MAIL DATE	DELIVERY MODE
			11/01/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**MAILED**

Application Number: 09/815,838

Filing Date: March 22, 2001

NOV 01 2007

Appellant(s): ICHO, ROBERT

**GROUP 3600**

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Harris Zimmerman  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the Appeal Brief filed on May 01, 2006 appealing from the Office

Action mailed on May 16, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**Claims 1-3 and 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeda et al. (hereinafter Ikeda), US Patent 5,937, 391.**

As per claims 1, 2, 3, 9-11, 12, 13 and 14, Ikeda discloses a point-service system (incentive reward program) for issuing points to a customer for purchases made at various stores or shops within an online shopping mall (first reward program) comprising a points issuing unit 1 of fig. 1 for issuing points based on purchase amounts of he customer or participant (col. 3: 52-53), a points management unit 2 of fig. 2 for storing the points (total points or base points) accumulated by the customer and a points redeeming unit 3 of fig. 1 for reducing a purchase amount of the customer upon redeeming points at any participating store within the mall. This system shortens the time from issuing points to redeeming points. In one embodiment, Ikeda discloses a service system wherein a specific customer makes a request to buy goods (participant's action) from a **home page or web site** of an online shopping mall and in response to this request, the service system causes the number of effective points (base points) accumulated by the customer and issued by a plurality of shops for each purchase made at each respective shop to be displayed on the customer's terminal or participant's unit, subsequent to identifying the customer or participant using the customer's or participant's ID, by referring to the data of each shop forming part of the online shopping mall. **If the customer still decides to order a product (participant's action), he can click on a shopping button associated with one of the displayed shops to subsequently access an order button or a particular shop server or web site and hence, the point-service system or service system linked to a web**

**server of the online shopping mall is activated to issue points or redeem points at the customer's request or instructions when he inputs an order** (displaying a plurality of vendors on the program or shopping mall web site) (see abstract; col. 2: 10-67; figs. 1-19). It is to be understood that a customer can explicitly or implicitly make a request from the point-service system to buy a product from a participating shop, redeem points or simply query the point-service system database for the effective points (base points) accumulated to date. It is further to be recognized that a participating shop or vendor may or may not have its own server or web server or web site. Here, the steps of registering and storing the user's registration information including an e-mail address, reporting purchases made by the user at one or more shops or vendors for the purpose of providing points or credits to the user based on the purchases amounts and reiterating or repeating the process of reporting or tracking the user's purchases and crediting the user's account are implicitly or explicitly supported by Ikeda (col. 4: 41-60; col. 5: 22-38; col. 4: 34-40; col. 10: 55 to col. 11: 3). **Additionally, the user or customer can access the online shopping mall or web site to check his or her number of accumulated and stored points and purchase history or information on the user's points stored under his account in a database can be periodically e-mailed to the user by a shopping mall or program web site administrator or manager, who also has an e-mail address** (or the process of e-mailing the customer may be carried out automatically using the manager's or program web site e-mail address) (col. 4: 34-38).

Moreover, the points issuing unit issues points based on the purchase amount of a customer or participant at an online shopping mall. The point issuing unit issues points based upon, for example, input information such as the name of the shop and the purchase amount and

the points issue ratio set for each shop. For example, the points issue ratio is indicative of how many points are issued when a customer or participant spends 100 Yen at a shop (1 point for every 100 Yen spent). The points issue ratio can also be set to a value larger than a normal value in a special campaign period such as an end-of-year sales period (col. 2: 28-37).

In addition, a points redeeming ratio performs a points redeeming process by reducing the purchase amount for a particular customer or participant during a transaction at a specific shop, based on the number of total points (base points or effective points) accumulated thus far throughout the system or at that shop, wherein the customer or participant chooses to redeem some of his points (base points) at the specific shop and wherein each participating shop has a different points redeeming ratio. For example, shop A of fig. 9 reduces during a certain period of time the customer's purchase by 1 Yen for every 1 point redeemed, hence a 1:1 ratio or redemption rate. Like the points issue ratio, the points redeeming ratio or redemption rate for a specific period, such as an end-of-year sales campaign, can be set to a value higher than a normal period (increasing or adjusting or providing a higher redemption points ratio or redemption rate to the customer if the customer performs an action such as purchasing products at a shop participating in the end-of-year sales campaign). (col. 2: 38-64; col. 3: 62-67; col. 8: 1-23; col. 9: 55 to col. 10: 2). In other words, each specific shop issues points to a customer or redeems the customer's effective points (base points) during a purchase transaction in accordance with the points issue ratio and points redemption ratio set for each specific shop during a specific period of time (**the shop or vendor issues or redeems points in accordance with its own prescribed points issuing and redeeming rates or ratios independent of the default ratios set by the program web site or shopping mall point service system**).

Finally, the steps of reporting a user's transaction data associated with a purchase or a redemption back to the shopping mall service system or program web site (especially if the shop or vendor uses its own server) for the purpose of providing points to the user for the purchase, for reconciling points after a redemption (especially when points issued from shop A are redeemed during a transaction at shop B and the redemption rate is unique) and for overall system management are implicitly supported by Ikeda. Further, it is silently disclosed that the points must be acquired from a points provider, as practiced in the art, such that, for example, a shop or vendor may have to acquire or purchase the points from the shopping mall service manager, especially if the shop distributes the points directly to the user (the shop may have to compensate the shopping mall manager for providing points to the registered users on behalf of the shop).

As per claims 1, 7, 8 and 13, although a points service system wherein a registered user conducts a purchase at a participating shop or vendor, which provides points or incentives to purchasers or registered users, and the transaction data related to the purchase are transmitted in real-time to the points issuing component of the system for rewarding or issuing points to the registered user based on the amount of the purchase, **however, Ikeda does not explicitly disclose** the steps of using by a registered user the e-mail address of the system manager or program web site during a transaction at a shop's or a vendor's web site, reporting **by the shop** the user's purchase transaction via e-mail to the program web site or shopping mall system using the program web site e-mail address received from the user during the purchase, confirming the

user's purchase with the shop via e-mail and sending by the program web site an e-mail confirmation to the registered user.

However, using an e-mail as a communication means between two or more parties in a variety of ways is well established and well taught in the art. For example, a user who registers for a scheduled event via a web site associated with the scheduled event may receive an e-mail confirmation or reminder from the web site. Furthermore, a user or purchaser who purchases a product from a web site may receive an e-mail from the site to, for instance, confirm the purchase, notify the user that the ordered item is out stock and will be delivered at a later date and so on and so forth.

It is also customary in the art to tag a user's visit to a referring web site where the user clicks on a product or on a related referral link, having embedded therein an ID uniquely identifying the referring web site or associate's web site, displayed thereon to thereby hyperlink to the product vendor's or advertiser's web site where the featured product is bought, wherein the vendor or advertiser compiles a complete and unique daily or weekly report, depicting the referred customers' or users' activities at the vendor's site, for the referring or associate web site and wherein the (transaction) report is sent to the referring or associate web site via e-mail using an e-mail of the referring web site and wherein the report is used to measure the system effectiveness and to accurately compensate the referring web site for the referrals.

Moreover, transmitting the user's purchase transaction with a participating shop to the shopping mall system or program web site via e-mail, rather than reporting the said purchase transaction in real-time transmission, as taught by Ikeda, from the shop, especially when the shop

is using its own server, to thereby is a matter of desires, which does not directly impact how the points or credits are issued and redeemed.

(“Official Notice”)

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure into the Ikeda’s point service system so as to have a registered user provide an identifier such as an e-mail address related to the shopping mall system manager or program web site, or to transparently extract from the user’s local browser the referring web site ID, during a transaction at an associated shop or vendor web site in order to report in substantially real-time the user’s purchase transaction via e-mail to the identified program web site or shopping mall system for confirming whether or not the current transaction is eligible to receive credits or points and if the current transaction is eligible to receive points, then the user is notified via e-mail that the transaction has been completed and that a certain number of points has been added to his account as a result of the current transaction, thereby making it possible to identify which program web site or shopping mall system the user conducting the current transaction belongs to or is associated with, especially when the shop or vendor or advertiser’s web site where the user is shopping is associated with more than one shopping mall system or program web site and/or the vendor or shop is using its own server to store product data and conduct business transactions (col. 4: 56-60).

### **(10) Response to Argument**

In general, the Appellant's arguments are broad in nature and offer no specific and direct remarks per se. The Appellant starts with a discussion of the prior art reference and the claimed invention and the alleged distinction between the two. First, the Appellant states that the distinctions of the present invention (i.e. claim 1) over Ikeda include the fact that Ikeda counts points for each shop separately, whereas the present invention instead sums the total dollar spent via the web site with no regard for individual shop totals (second paragraph of page 11). Second, on page 13 of the Brief, Appellant makes the following point: "**claim 1 states that the registered user transacts a purchase directly with the web site of one of the participating vendors.**" That is, the web site of the award- incentive program does not enter into the conduct of the transaction. **Further, claim 1 requires that the registered user's purchase through the award incentive web site is reported after the purchase is complete.** Ikeda cannot conduct business in this manner, since it intervenes in the midst of the transaction (as soon as the order button is pushed) and requires that points be awarded and/ or redeemed during the transaction. Thus, claim 1 defines the invention over the reference and should be allowed." In other words, Appellant contends here that Ikeda cannot interact with a vendor's website for purchase points award and redemption unless the vendor website is significantly modified, which is not desired by the vendors or merchants (first paragraph of page 11).

In reply, the Examiner completely and respectfully disagrees with the Appellant's conclusion. In fact, the present invention or at least claim 1 does not specifically recite a system that **sums the total dollar spent via the web site with no regard for individual shop totals**

(second paragraph of page 11). It appears rather that the Appellant is arguing limitations that are not necessarily claimed. Here, the Examiner wants to remind the Appellant that although the Examiner interprets the claims in view of the specification, however, the Examiner does not read limitations from the specification directly into the claims. At this point, even if Ikeda, the primary reference, accumulates a user's points collected from a plurality of vendors/shops and separates the points per shop and the present claimed invention (claim 1) rather sums up dollars spent, however, the distinction does not amount to a patentable feature/difference.

Furthermore, and in general, Ikeda discloses a point-service system (incentive reward program) for issuing points to a customer for purchases made at various stores or shops within an online shopping mall (first reward program) comprising a points issuing unit 1 of fig. 1 for issuing points based on purchase amounts of he customer or participant (col. 3: 52-53), a points management unit 2 of fig. 2 for storing the points (total points or base points) accumulated by the customer and a points redeeming unit 3 of fig. 1 for reducing a purchase amount of the customer upon redeeming points at any participating store within the mall. This system shortens the time from issuing points to redeeming points. In one embodiment, Ikeda discloses a service system wherein a specific customer makes a request to buy goods (participant's action) from **a home page or web site** of an online shopping mall and in response to this request, the service system causes the number of effective points (base points) accumulated by the customer and issued by a plurality of shops for each purchase made at each respective shop to be displayed on the customer's terminal or participant's unit, subsequent to identifying the customer or participant using the customer's or participant's ID, by referring to the data of each shop forming part of the online shopping mall. **If the customer still decides to order a product (participant's action),**

**he can click on a shopping button associated with one of the displayed shops to subsequently access an order button or a particular shop server or web site and hence, the point-service system or service system linked to a web server of the online shopping mall is activated to issue points or redeem points at the customer's request or instructions when he inputs an order** (displaying a plurality of vendors on the program or shopping mall web site) (see abstract; col. 2: 10-67; figs. 1-19). It is to be understood that a customer can explicitly or implicitly make a request from the point-service system to buy a product from a participating shop, redeem points or simply query the point-service system database for the effective points (base points) accumulated to date. It is further to be recognized that a participating shop or vendor may or may not have its own server or web server or web site. Here, the steps of registering and storing the user's registration information including an e-mail address, reporting purchases made by the user at one or more shops or vendors for the purpose of providing points or credits to the user based on the purchases amounts and reiterating or repeating the process of reporting or tracking the user's purchases and crediting the user's account are implicitly or explicitly supported by Ikeda (col. 4: 41-60; col. 5: 22-38; col. 4: 34-40; col. 10: 55 to col. 11: 3). Additionally, the user or customer can access the online shopping mall or web site to check his or her number of accumulated and stored points and purchase history or information on the user's points stored under his account in a database can be periodically e-mailed to the user by a shopping mall or program web site administrator or manager (or the process of e-mailing the customer may be carried out automatically using the manager's or program web site e-mail address) (col. 4: 34-38).

In the above discussion, it is assumed that the shops or vendors A, B, C and so on do not have their own servers or associated web sites and depend on the shopping mall sever or website . However, contrary to the Appellant's remarks, the shops or vendors can also have their own servers and hence, their own web sites and can simultaneously enter another online shopping mall. In other words, when the shops or vendors use their own (web) servers or web sites to sell products directly to a user who logs into the shopping mall system, then the shopping mall web site is used as a program web site (input or interface) to facilitate the diverse operations of the point or incentive system. It is further understood here, contrary to the Appellant's remarks, that the user logs into the shopping mall system or web site where the user is transported to a vendor's or shop's web site (server) to conduct a transaction or purchase an item/product, when the shop uses its own server or web site, upon clicking on the (shopping) button displayed on the shopping mall web site, as would have concluded one of ordinary skills in the art. Having said that, and contrary to the Appellant's contention, Ikeda's system is adapted to interact with a vendor's/shop's server or website (i.e. a vendor's web sever having a web site) without any undesired modification (fig, 2; col. 4: 41-60).

Additionally, contrary to the Appellant's position, the Examiner clearly points out the deficiency in the prior art, which was compensated using publicly known disclosure ("Official Notice") and the combination of the public disclosure ("Official Notice") with the Ikeda's reference does indeed address the claimed invention, while rendering it obvious under 35 U.S.C 103(a).

Therefore, the Appellant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the 's arguments as herein presented are not plausible and thus, the rejections should be sustained.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees:

Eric Stamber *ES*

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JDJ

10/26/07

JEAN D. JANVIER  
PRIMARY EXAMINER

*Jeanne Janvier*